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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,440	02/28/2006	Marc Husemann	101769-309-WCG	3424
27386 7590 08/21/2008 NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022				
EXAMINER				
DESAL, ANISH P				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/537,440

**Applicant(s)**

HUSEMANN ET AL.

**Examiner**

ANISH DESAI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

#### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed on 06/05/08 after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/05/08 has been entered.
2. Claims 1-6 and 8-15 are pending. Claim 7 is cancelled.
3. All of the previously made 35 USC Section 112-second paragraph rejections are withdrawn in view of the present amendment and response. However, upon further consideration a new 35 USC Section 112-first paragraph rejection is made to newly amended independent claim 1.
4. The 35 USC Section 102(b) rejections based on Akhter (US 5,958,537) are withdrawn because Akhter does not teach or suggest that a first PSA is free of electrically conductive particles as required by claim 1. However, upon further consideration, a new 35 USC Section 102(b) rejection based on newly discovered reference of Wallner (US 3,146,882) is made.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-6 and 8-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

6. Regarding newly added claim 1 limitation requiring that the PSA layer be free of electrically conductive particles, the specification does not provide the support for the exclusion of the electrically conductive particles from the PSA layer. While it is noted that Applicant in his/her response has cited certain pages and lines from the specification to show the support for the aforementioned limitation. However, it is respectfully submitted that, **any negative limitation or exclusionary proviso must have basis in the original disclosure.** If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), aff'd mem., 738 F.2d 453 (Fed. Cir. 1984). **The mere absence of a positive recitation is not basis for exclusion.** Any claim containing a negative limitation, which does not have basis in the original disclosure, should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement (MPEP 2173.05(i)). The specification as originally filled does not provide any recitation that would either indicate that the addition of electrically conductive particles in the PSA is undesirable or not needed.

***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Wallner (US 3,146,882).
8. Wallner teaches an antistatic PSA tape comprising a backing coated with antistatic primer layer (first electrically conductive primer layer), and a layer of PSA (first PSA) applied to the antistatic primer layer (column 1 lines 10-40). Moreover, Wallner is silent as to teaching of the presence of electrically conductive particles in the PSA of his/her invention. Further, Wallner discloses polyacrylate adhesives at column 2 line 10. Accordingly, Wallner anticipates the claimed invention.

9. Claim 6 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) as applied to claim 1.

10. Although Wallner is silent as to teaching the first adhesive layer exhibits shrinkback, it is reasonable to presume that said feature of shrinkback is present in the adhesive tape of Wallner. The support for said presumption is based on the fact that the adhesive tapes of Wallner and that of Applicant comprise a carrier layer, a first electrically conductive primer layer between the carrier layer and a first PSA layer, wherein the PSA is free of electrically conductive particles. Thus, the PSA tapes of Wallner and that of Applicant are structurally and compositionally equivalent. Therefore, it is respectfully submitted that the aforementioned claimed feature would be present in the invention of Wallner. The burden is shifted to Applicant to prove it otherwise (see *In re Fitzgerald*, 205 USPQ 594).

11. Claims 2-4 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallner (US 3,146,882) as applied to claim 1 and further in view of Akhter (US 5,958,537).

12. Wallner is silent as to teaching claims 2-4 and 11-13. However, Akhter discloses a static dissipative label (antistatic pressure-sensitive adhesive tape) comprising a backing film (carrier layer), at least one pressure-sensitive adhesive layer, and a primer layer containing electrically conductive particles (electrically conductive materials) that is between the carrier layer and the pressure-sensitive adhesive layer (abstract, column 1 lines 4-11, column 1 line 65 to column 2 lines 1-18, and Figure). The electrically

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conductive particles of Akhter are metal particles (column 3 lines 29-30) and the electrically conductive materials of Akhter are homogeneously dispersed throughout the binder resin matrix of the primer layer (column 2 lines 4-12). Additionally, the primer layer of Akhter comprises conductive polymers such as polyaniline (column 2 lines 5-13 and column 4 lines 1-3), which reads on electrically conductive conjugated polymers. Alternatively, Akhter further discloses the primer layer comprising conductive particles comprising (i) inorganic oxides coated with a conductive material (column 2 lines 5-13 and column 3 lines 29-67), which reads on the electrically doped material. Further, Akhter discloses that typically the conductive particles comprise at least about 30, preferably at least about 40 and more preferably at least about 50 weight percent of the combined weight of the binder resin and conductive particles (column 3 lines 44-47).

13. It is noted that the primary reference of Wallner discloses an antistatic PSA tape having a primer layer that is antistatic (electrically conductive). Wallner is silent as to teaching electrically conductive particles in his/her primer layer; instead Wallner discloses use of conductive polymers. The secondary reference of Akhter discloses antistatic label which comprises a primer layer having electrically conductive material such as electrically conductive particles or conductive polymers (column 2 lines 5-15). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the electrically conductive material as required by claims 2-4 and 11-13 and as taught by Akhter, because selecting a known material based on its intended use establishes a *prima facie* case of obviousness (MPEP 2144.07).

14. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallner (US 3,146,882) as applied to claim 1 and further in view of Kitamura et al. (US 5,759,679).

15. Regarding claims 8 and 9, it is noted that Wallner is silent as to teaching the structure of the PSA tape as required by claims 8 and 9. Specifically, Wallner is silent as to teaching a second PSA layer connected to the carrier layer, a second electrically conductive primer layer between the second PSA and the carrier layer (claim 8), and the second PSA layer connected to the carrier layer as required by claim 9. However, the reference of Kitamura is relied upon to show that such a structure of the PSA tape is known in the art. For example, Kitamura discloses an adhesive tape with foamed substrate (carrier) (abstract). Further, Kitamura discloses that the PSA layer can be applied on one or both sides of the foamed substrate (carrier) (column 7 lines 14-20). Additionally, Kitamura discloses that in order to improve the anchoring property of the PSA layers, an undercoat treatment (primer layer) is applied to the surface(s) of the carrier layer (column 7 lines 30-40). Additionally, Example 1-1 of Kitamura discloses application of undercoat to both sides of the carrier and application of PSA layers on both surfaces of the carrier layer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide PSA tape with the structure as presently claimed, motivated by the desire to form a suitable PSA tape.



16. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wallner (US 3,146,882) as applied to claim 1, and further in view of Luhmann et al. (US 6,395,389B1).

17. Wallner is silent with respect to disclosing the PSA tape in the form of punched product. However, such punched tapes are known in the adhesive art as disclosed by Luhmann. The invention of Luhmann is directed to an adhesive tape strip (see abstract). According to Luhmann "Typical presentation forms [of the adhesive tape] include, punched adhesive tape strip sections covered on one side with a release laminate...forms." (column 4 lines 28-45). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the tape in the form of a punched product because doing so involves routine skill in the art.

18. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wallner (US 3,146,882) as applied to claim 1, and further in view of Craig et al. (US 6,299,799B1).

19. Wallner is silent with respect to teaching electrically conductive conjugated polymers are 3,4 polyethylenedioxythiophene. However, Craig discloses creamer compositions that are capable of being cured to form antistatic, abrasion resistant creamers. Further the creamer compositions of Craig comprise electrically conductive organic polymers (abstract). The creamer compositions of Craig can be coated onto a substrate that can be a part of a pressure-sensitive adhesive tape (column 4 lines 1-9). Further, Craig discloses 3,4 polyethylenedioxythiophene (3,4 PEDT), polyaniline, and

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polypyrrole as electrically conductive polymers (column 4 lines 33-37). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use 3,4 polyethylenedioxythiophene in the invention of Wallner because selecting a known material based on its suitability for its intended use (purpose of providing static dissipation of charge) involves routine skill in the art.

20. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wallner (US 3,146,882) as applied to claim 1, and further in view of De Jonge et al. (US 6,284,837B1).

21. The invention of Wallner is previously disclosed. Wallner is silent with respect to teaching polymethacrylate PSA. However, De Jonge discloses PSA tapes and labels comprising polymethacrylate adhesives (see abstract and column 1 lines 35-40). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the polymethacrylate PSA as taught by De Jonge in the invention of Wallner, motivated by the desire to use a suitable adhesive to form a PSA tape.

### ***Response to Arguments***

22. Applicant's arguments received on 06/05/08 have been fully considered but they are moot in view of the new ground(s) of rejection.

**Conclusion**

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.
24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./  
Examiner, Art Unit 1794

/Hai Vo/  
Primary Examiner, Art Unit 1794